

REMARKS

Claim rejections under 35 USC 103

Claims 1 and 2 have been rejected under 35 USC 103(a) as being unpatentable over Lehureau (4,025,784) in view of Tanaka (6,608,809). Claims 3-4 and 6-8 have been rejected under 35 USC 103(a) as being unpatentable over Lehureau in view of Tanaka, and further in view of Lehureau (2004/0027964). Claim 5 has been rejected under 35 USC 103(a) as being unpatentable over Lehureau in view of Tanaka, and further in view of Freeman (6,901,598). Claim 1 is an independent claim, from which claims 2-8 ultimately depend. Applicant respectfully submits that at least as amended, claim 1 is patentable over Lehureau in view of Tanaka. Therefore, claims 2-8 are patentable at least because they depend from a patentable base independent claim.

Applicant provides three reasons why claim 1 is patentable over Lehureau in view of Tanaka. First, Lehureau in view of Tanaka does not teach, suggest, or disclose the added limitations of claim 1. Second, the Examiner has not provided a proper reason to modify Lehureau in view of Tanaka, such that claim 1 is not *prima facie* obvious over Lehureau in view of Tanaka. Third, there is actually no proper reason to modify Lehureau in view of Tanaka, such that claim 1 is not *prima facie* obvious over Lehureau in view of Tanaka. Each of these reasons is now discussed in detail.

(1) Added limitations of claim 1 not suggested by Lehureau in view of Tanaka

Applicant first submits that Lehureau in view of Tanaka does not teach, suggest, or disclose the added limitations of claim 1. Claim 1 has been amended to “pass[] a light source beam *towards a label side of a storage media also having a data side opposite to the label side*, over a reflectivity change *visible from the label side* of the storage media, and onto a leading photo sensor and a trailing photo sensor.” As such, the focus actuator is adjusted to move a focus lens farther from or closer to the “*label side* of the storage media.” Applicant refers the

Examiner to at least paragraphs [21], [22] and [23], and FIG. 3, for support of this amendment. For instance, in paragraph [22], the reflectivity change is described as being visible to the optics system from the label side of the storage media. In paragraph [23], the reflectivity change is described as being able to be read from the label side of the storage media, and in paragraph [21], laser light is described as focused on the label layer of the media. In FIG. 3, the laser light is passed towards the label side 30 of the storage media, where this label side 30 is opposite the data side 26 of the storage media.

Lehureau in view of Tanaka does not suggest these added limitations to claim 1, because neither Lehureau in view of Tanaka disclose them, such that the combination of Lehureau in view of Tanaka cannot suggest the limitations. In Lehureau, a data carrier 1 is described that has a track with a succession of diffractive elements, such as the diffractive element 2. (Col. 2, ll. 7-9.) At best, the data carrier 1 corresponds to the data side of the storage media of claim 1, such that the light source beam in Lehureau is passed towards the data side, not towards the label side of the storage media. (See also, col. 1, ll. 20-22, in which the light source beam is effectively passed towards the “data carrier surface,” which at best corresponds to the data side of claim 1, not the label side.) Lehureau does not describe a “reflectivity change visible from the label side of the storage media.”

Likewise, Tanaka relates to optical disks “such as CDs (Compact Discs) and DVDs (Digital Versatile Discs)” (col. 1, ll. 8-10), where the optical disk has an “information recording area.” (Col. 2, ll. 25-30.) Such an “information recording area” best corresponds to the data side of claim 1, not the label side. Tanaka also does not describe a “reflectivity change visible from the label side of the storage media.” Therefore, because neither Lehureau nor Tanaka discloses passing a light source beam “towards a label side of a storage media also having a data side opposite to the label side,” nor a reflectivity change “visible from the label side of the storage media,” claim 1 as amended is patentable over Lehureau in view of Tanaka.

(2) No proper reason provided to modify Lehureau in view of Tanaka

Applicant also contends that the Examiner has not provided a proper reason that prompts one of ordinary skill within the art to modify Lehureau in view of Tanaka to yield the claimed invention. The Supreme Court in its recent decision KSR Int'l Co. v. Teleflex, Inc., 550 US _____ (2007) stated that the Examiner must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (KSR, at 14.) More specifically, the Examiner must "identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." (Id., at 15.) Applicant further importantly notes in this respect that "[t]he mere fact that references CAN be combined or modified does not render the resultant combination obvious." (MPEP sec. 2143.01.III, citing In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990))

The Examiner's rationale for modifying Lehureau in view of Tanaka is that "[i]t would have been obvious to provide for non-reflective [areas, as in Tanaka] instead of the less-reflective areas of Lehureau as it would have been a simple substitution of one known element for another to obtain predictable results." (Office action, p. 3.) However, this stated rationale is not "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." Even if the substitution of non-reflective areas for less-reflective is "simple," and would "obtain predictable results," this is not a reason that would have prompted one of ordinary skill within the art to make the substitution, contrary to the Supreme Court's decision in KSR. Indeed, that such a substitution is simple and would obtain predictable results actually just relates to the fact that Lehureau *could* be modified in view of Tanaka. However, as the Federal Circuit makes clear in Mills, as cited in MPEP sec. 2143.01.III, just because a reference *can* be modified in view of another does not render the resultant combination obvious. For this reason as well, claim 1 is patentable over Lehureau in view of Tanaka.

(3) No proper reason to modify Lehureau in view of Tanaka to yield the claimed invention

Applicant finally submits that there is actually no proper reason to modify Lehureau in view of Tanaka to yield the claimed invention. As has been noted above, the Supreme Court has stated in KSR that there has to be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. However, it is impermissible to use the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious; one cannot use hindsight reconstruction to pick and choose among the prior art to deprecate the claimed invention. (In re Fritch, 972 F.2d 1260 (Fed Cir. 1992)) Furthermore, the suggested combination of references cannot require a substantial reconstruction and redesign of the elements shown in the primary reference or a change in the basic principle under which the [primary reference] construction was designed to operate. (In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), cited in MPEP sec. 2143.02.VI)

Applicant now reviews the teachings of Lehureau and Tanaka to determine what these references actually teach, and suggest in combination with one another, without considering the claimed invention as a template. In FIGs. 1-3 of Lehureau, a laser beam is passed between one diffractive element or impression 2 to another within a given track. (See, e.g., col. 2, ll. 7-10.) Tanaka’s non-reflective areas pertain to the boundary areas being recording areas, as depicted in FIG. 3, where the boundary areas can be “non-reflective areas.” (Col. 5, ll. 41-44.) It is clear in reviewing FIG. 3 of Tanaka, that the boundary area does not separate diffractive elements or impressions within the same track, but rather separates entire tracks of diffractive elements or impressions. For instance, in FIG. 3 of Tanaka, the tracks are shown on the right-hand side, as part of the recording area, where the tracks have individual diffractive elements or impressions. However, the point of Lehureau is that you can focus on individual diffractive elements or impressions, as you proceed from diffractive element/impression to diffractive element/impression on the same track. (See, e.g., FIGs. 2 and 3 of Lehureau, in which you pass from one such

element/impression to another such element/impression.) Tanaka, by comparison, is not concerned with *focusing* on individual diffractive elements or impression within a given track, but rather with *moving* between entire recording areas of tracks of diffractive elements or impressions. (See, e.g., FIG. 3, which again shows the boundary area as being between two recording areas.)

Therefore, the logical conclusions we can draw by reviewing Lehureau in view of Tanaka as a whole are as follows:

- (1) There is no reason to modify Lehureau in view of Tanaka to yield the claimed invention, because the boundary area of Tanaka that the Examiner relies upon as teaching the reflectivity change of the claimed invention is not used for focusing purposes at all, but solely to distinguish between adjacent recording areas.
- (2) Without using the claimed invention as a template to piece together Lehureau in view of Tanaka, which is impermissible, one of ordinary skill within the art would simply modify Lehureau so that its tracks of diffractive elements would further be organized within recording areas separated by boundary areas. However, such boundary areas have no utility in focusing on the individual diffractive elements in Lehureau, such that the resulting combination does not suggest the invention of claim 1.
- (3) Likewise, the only way to modify Lehureau in view of Tanaka to yield the claimed invention requires impermissible hindsight and would in fact require a major reconstruction and redesign of the optical disc. One of ordinary skill within the art would first have to have a reason to have a boundary area between successive diffractive elements or impressions, which neither Lehureau nor Tanaka teaches, and which Tanaka actually teaches away from by teaching a boundary area between adjacent recording areas. Even if there is a reason to have such a boundary area between successive diffractive elements or impressions, there is no teaching within the prior art that such a modification is even possible with modern optical disc fabrication technology. In other

words, contrary to the Examiner's assertion without any explanation or support, it is not a foregone conclusion that having a *non-reflective* area between diffractive elements or impressions is a "simple substitution." There has to be a reason, in other words, why every optical disc that Applicant is aware of is reflective (and not *non-reflective*) on its data side, and for the Examiner to formulate a conclusion that belies 20+ years of optical disc technology, surely he has to provide a satisfactory explanation in this regard.

For these reasons as well, therefore, claim 1 is patentable over Lehureau in view of Tanaka.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



December 19, 2007

Date

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